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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,966	08/27/2001	Li Chen	1095	5412

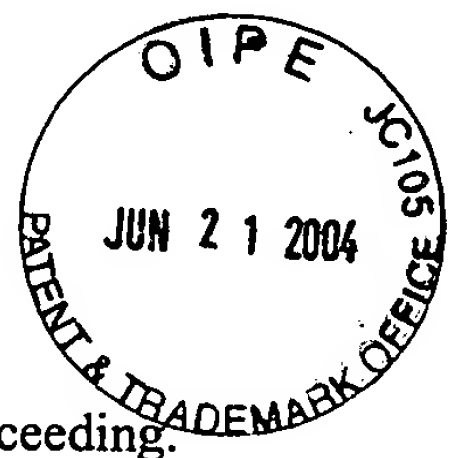
151 7590 03/18/2004  
HOFFMANN-LA ROCHE INC.  
PATENT LAW DEPARTMENT  
340 KINGSLAND STREET  
NUTLEY, NJ 07110



EXAMINER  
LUKTON, DAVID

ART UNIT 1653  
PAPER NUMBER

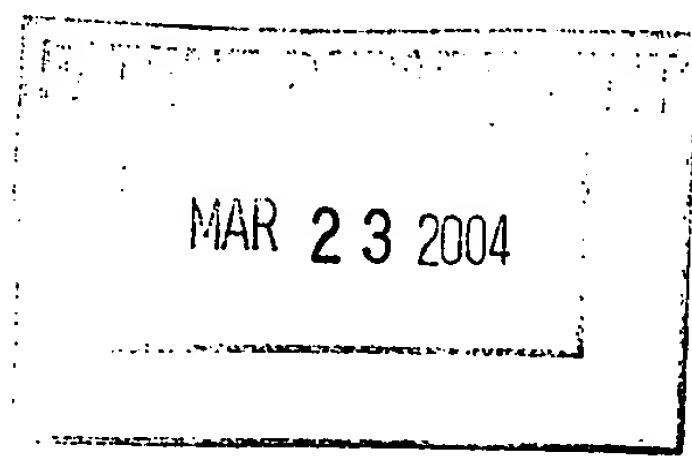
DATE MAILED: 03/18/2004



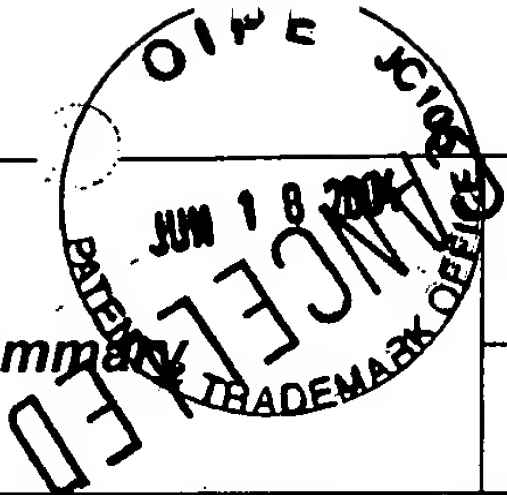
Please find below and/or attached an Office communication concerning this application or proceeding.

RESPONSE DUE:	<u>June 18, 2004</u>
STATUTORY PERIOD EXPIRES:	<u>Sept. 18, 2004</u>

bak



**Office Action Summary**



Application No.

09/939,966

Applicant(s)

CHEN ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 75 and 76 is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

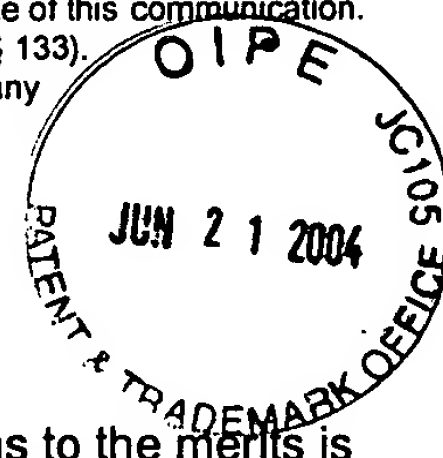
**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/26/02; 4/24/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



The abstract is objected to. The sentence of the abstract should be grammatically correct.

Following is one option:

*Peptides cyclized via disulfide or lactam bridges are disclosed. The peptides exhibit melanocortin-4 receptor agonist activity and are useful for treating obesity*

\*

Claims 1-74 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In several claims (e.g., 1, 2, 9, 25, 34, 35, 54, 55), variable R<sup>9</sup> is defined as a substituent which contains an indole group. A hydrogen atom is missing from the indole nitrogen atom.
- Claim 5 recites (last line) that "n" and R<sup>14</sup> are defined "as above". The claim should make it clear what "above" refers to. See also claim 9, last line and claim 55, last line.

\*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at 571-272-0951. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

*D. Lukton*

DAVID LUKTON  
PATENT EXAMINER  
GROUP 1800 1600



Substitute for form 1449A/PTO		Complete if Known	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Use several sheets if necessary)		Application Number	09/939,966
		Filing Date	August 27, 2001
		First Name Inventor	Li Chen et al.
		Group Art Unit	1646
		Examiner Name	
Sheet 2 of 2	Attorney Docket Number	1095	

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
	C1	Fan et al., Nature, Vol. 385, pgs. 165-168 (1997)	
	C2	Cone et al., Rec. Prog. Hormone Research, Vol. 51, pgs. 287-318 (1996)	
	C3	Haskell-Luevano et al., Peptides, Vol. 17, No. 6, pgs. 995-1002 (1996)	
	C4	R. B. Merrifield, J. Amer. Chem. Soc., Vol. 85, pgs. 2149-2154 (1963)	
	C5	Barany et al., The Peptides, Analysis, Synthesis and Biology, Vol. 2, E. Gross and J. Meienhofer, Eds. Academic Press, pgs. 1-284 (1980)	
	C6	Kaiser et al., Anal. Biochem., 34, pgs. 595-598 (1970)	
	C7	Obrecht et al., Helv. Chim. Acta, Vol. 75, pgs. 1666-1696 (1992)	
	C8	Freeman et al., J. Org. Chem., Vol. 54, pgs. 782-789 (1989)	
	C9	Boteju et al., Tet. Lett., 33 pg. 7491-7494 (1992)	
	C10	Nicholas et al., J. Org. Chem. 58, pgs. 766-770 (1993)	
	C11	Bednarek et al., Biochem. Biophys. Res. Comm. 261, pgs. 209-213 (1999)	
	C12	Bednarek et al., Peptides 20, pgs. 401-409 (1999)	
Examiner Signature			DATE CONSIDERED 3-11-04

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Unique citation designation number. <sup>2</sup> Applicant is to place a check mark here if English language Translation or abstract is attached.

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